

Remarks

Upon entry of the above amendment, claims 7-9, 12-13, 18-20, 22, 25-33 will be pending in the instant application. Claims 25-32 are withdrawn from examination due to restriction, however, Applicants respectfully request rejoinder once the compounds are found allowable. Applicants have canceled claims 1-6, 10-11, 14-17, 21, 23-24 and 34-39 without prejudice to the subject matter contained therein.

Restriction Requirement

Applicants acknowledge the restriction requirement being made final. Applicants request rejoinder once compounds claims found allowable.

Issue Under 35 U.S.C. §112, first paragraph

Claims 1-3, 7-9, 11-13, 18-20, 22 and 33 stand rejected under 35 U.S.C. §112 first paragraph as allegedly not being enabling for the full scope of the defined markush groups of R¹ and R² and R⁶-R⁸. Applicants respectfully traverse this assertion.

Applicants amended the claims to address some of the concerns raised by the Examiner. However, Applicants believe tremendous support does exist for heterocyclic, aryl and heteroaryl groups as claimed in R⁶-R⁸. The Examiner lists 12 different heterocyclic, aryl and heteroaryl group which are representatives of a much greater series of possible compounds. It is well accepted in U.S. Patent law that an Applicant is not limited to the scope of the experimental section.

In addressing the In re Wands factors, Applicants have generated numerous examples covering a broad scope of possibilities. Applicants have provided sufficient guidance as to how to make the invention. The variables R⁶-R⁸ are amide and ester substituents. The chemistry behind the formation of amide substituent and esters is well established. A skilled artisan would be enabled to expand upon the explicitly disclosed derivatives to make the compounds claimed. The availability of starting material is not relevant in the present case.

Chemistry is the unpredictable art. Dr. Dorwald's prose is one person's understanding of research. However, personal experience has proven that organic chemistry research within the industry is quite different than in the academic world. Industrial organic chemists do not spend most of their time "finding out what went wrong and why." Therefore, Dr. Dorwald's prose has no relevance as to the underlying enablement of the present invention.

Applicants respectfully submit that the amended claims are enabled. Applicants respectfully request withdrawal of the 35 U.S.C. §112 rejection.

Issue Under 35 U.S.C. §102(e)

Claims 1, 2, 3, 18, 19, 20, 22 and 33 stand rejected under 35 U.S.C. §102(e) as being allegedly anticipated by Matsumoto '199 (WO 2003/029199). Applicants respectfully traverse this assertion.

Matsumoto '199 discloses a series of benzene derivatives which contain three substituents: a urea group, a carbonyl and a large ether group. Example 396, on page 117 discloses an iso octahydroquinoline carbonyl derivative with an ether para to the carbonyl and a urea group meta to the carbonyl. Example 396 fails to anticipate any compound within the amended claim scope. The present invention does not claim to have an ether group para to the carbonyl octahydroisoquinoline.

Applicants respectfully request withdrawal of the 35 U.S.C. §102(e) rejection.

Issue Under 35 U.S.C. §102(b)

Claims 1, 2, 3, 8, 9, 11 and 33 stand rejected under 35 U.S.C. §102(b) as being allegedly anticipated by Luts (J. Pharm. Sci. 1971, 60, 1409-1411). Applicants respectfully traverse this assertion.

Luts discloses a series of benzene derivatives which contain three methoxy substituents and carbonylamide. Example 1, on page 1410 discloses an octahydroquinoline carbonyl derivative with three methoxy groups. Example 1 fails to anticipate any compound within the amended claim scope. The present invention does not claim to have an ether group para to the carbonyl octahydroquinoline.

Applicants respectfully request withdrawal of the 35 U.S.C. §102(b) rejection.

Issue Under 35 U.S.C. §102(b)

Claims 1, 2, 3, 7, 8, 9, 11 and 33 stand rejected under 35 U.S.C. §102(b) as being allegedly anticipated by Ogawa '113 (WO 94/01113A1). Applicants respectfully traverse this assertion.

Ogawa '113 discloses a series of benzene derivatives. Throughout the disclosure carbonyl tetrahydroquinoline carbonyl derivatives are exemplified. However, Ogawa '113 fails to anticipate any compound within the amended claim scope because no octahydroquinoline or octahydroisoquinoline are exemplified or suggested. The present invention does not claim to have a carbonyl tetrahydroquinoline.

Applicants respectfully request withdrawal of the 35 U.S.C. §102(b) rejection.

Conclusion

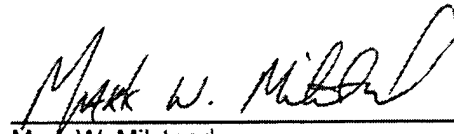
Applicants have addressed each and every issue set forth by the Examiner. Applicants respectfully submit that the present application is in good condition for allowance.

If the Examiner believes for any reason that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (617) 871-4125.

If necessary, the Commissioner is hereby authorized in this, concurrent, and further replies, to charge payment or credit any overpayment to Deposit Account No. 50-4409 for any additional fees under 37 C.F.R. §1.16 or under 37 C.F.R. §1.17; particularly extension of time fees.

Respectfully submitted,

Novartis Institute for Biomedical Research
NIBR Patents
400 Technology Square
Cambridge, MA 02139
(617) 871-4125


Mark W. Milstead
Attorney for Applicant
Reg. No. 45,825

Date: August 10, 2008